

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : **HOFFBECK, Mark David**
SERIAL NO : 10/785,146
FILED : February 24, 2004
TITLE : INBRED MAIZE LINE PH3RC

Grp./A.U. : 1638
Examiner : MEHTA, Ashwin D.
Conf. No. : 8164
Docket No. : P06268US02 - PHI 1433C

Commissioner for Patents
Attention: Refund Section, Accounting Division, Office of Finance
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REFUND
(Improper charge of Deposit Account)
(37 CFR 1.26(b))

I. REFUND REQUEST

This is a request for a refund with respect to the charge to Deposit Account 26-0084 shown on the statement for the month of February, 2007 for the above-identified application.

A copy of the monthly statement, page 4, in which the error referred to occurs accompanies this request.

=====

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

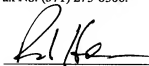
MAILING

☐ deposited with the United States Postal Service with sufficient postage as First Class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 3/8/07

FACSIMILE/ELECTRONIC

☒ transmitted by facsimile/electronic to the Patent and Trademark Office, Art Unit 1638 at Fax No. (571) 273-8300.


Robert A. Hodgson

II. FEES CHARGED

Code 1202	Claims in excess of 20	\$650.00
Code 1201	Independent claims in excess of 3	\$600.00
Code 1201	Independent claims in excess of 3	\$200.00

III. EXPLANATION OF WHY CONTESTED CHARGE IS IN ERROR

The Preliminary Amendment filed June 16, 2005 had one new independent claim in excess of 3 and we should have charged \$200.00. However, the Second Preliminary Amendment filed September 15, 2005 included this independent claim in the total. Attached as Exhibit A is the 9/15/2005 Amendment showing "independent" versus "dependent" claims. The PTO made an error in charging the additional amount according to our calculations with this Amendment. As seen on the last page of the 9/15/2005 Amendment, the amount charged to Deposit Account should be \$1,100 and therefore, the Deposit Account should be credited in the amount of \$350.00.

The Amendment filed January 31, 2007 had no additional claims submitted.

What should only have been charged is:

Code 1202	Claims in excess of 20	\$700.00
Code 1201	Independent claims in excess of 3	\$400.00
	TOTAL	\$1,100.00

SEE EXHIBIT A ATTACHED, pages 1-10 (9/15/2005 Second Prelim Amendment) - marked on this exhibit are independent/dependent claims.

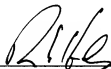
IV. MANNER OF REFUND

Please make refund by

☒ crediting Deposit Account No. 26-0084 in the amount of \$350.00.

☐ refunding payment

Respectfully submitted,



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Phone No. (515) 288-3667
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CUSTOMER NO: 27142

Attorneys of Record

02/13 750	11673822	P07110US01	4011	\$75.00	\$19,4
02/13 751	11673822	P07110US01	2111	\$250.00	\$19,1
02/13 752	11673822	P07110US01	2311	\$100.00	\$19,0
02/13 753	11673822	P07110US01	2202	\$50.00	\$19,0
02/13 22	5959082	P04666US02 - P763-22	2552	\$1,150.00	\$17,8
02/13 154	11673822	P07110US01; C922-3	8021	\$40.00	\$17,8
02/13 204	5947041	P01628US00; L326-0	2552	\$1,150.00	\$16,6
02/14 131	10762610	P06433US00	2251	\$60.00	\$16,6
02/14 132	10762610	P06433US00	2801	\$395.00	\$16,2
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02/14 1991	11466015	P07576US01	2201	\$200.00	\$15,7
02/14 967	78509185	B005-15 78/509,185	7005	\$100.00	\$15,6
02/14 1787	77107079	F927-4	7001	\$325.00	\$15,3
02/14 3267	11674707	P07434US01	4011	\$75.00	\$15,2
02/14 3268	11674707	P07434US01	2111	\$250.00	\$15,0
02/14 3269	11674707	P07434US01	2311	\$100.00	\$14,9
02/14 3278	10741262	P06274US01	1814	\$130.00	\$14,8
02/14 3318	11459084	P07277US02	2051	\$65.00	\$14,7
02/14 3319	11459084	P07277US02	2253	\$510.00	\$14,2
02/14 590	11674707	P07434US01; C110-31	8021	\$40.00	\$14,1
02/14 594	11459084	P07277US02; I006-674	8021	\$40.00	\$14,1
02/14 595	11670153	P07805US01 - R016-3	8021	\$40.00	\$14,1
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02/14 2019	77107183	H445-25	7001	\$325.00	\$13,6
02/14 2044	78821724	E035-1 78/821,724	7001	\$325.00	\$13,3
02/14 2093	77107211	T222-36	7001	\$325.00	\$13,0
02/14 2122	77107222	O007-33	7001	\$325.00	\$12,7
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02/15 1	5975804	P00023US00 - B665-0	2552	\$1,150.00	\$11,5
02/15 118	60856124	P07559US00 - PHI 2323	8021	\$40.00	\$11,4
02/15 127	60856123	P07652US00 - PHI 2273 PHI	8021	\$40.00	\$11,4
02/15 136	60856123	P07652US00; PHI 2273 ABR	8021	\$40.00	\$11,4
02/15 1660	1063505	C409-00 1,063,505	7205	\$200.00	\$11,2
02/15 1661	1063505	C409-00 1,063,505	7201	\$800.00	\$10,4
02/15 3580	10741562	P06267US01	1814	\$130.00	\$10,2
02/16 3	E-REPLENISHMENT		9203	-\$20,000.00	\$30,2
02/16 359	2069769	P035-1 2,069,769	7205	\$100.00	\$30,1
02/16 360	2069769	P035-1 2,069,769	7201	\$400.00	\$29,7
02/16 1245	60890101	P07876US00	1005	\$200.00	\$29,5
02/16 1371	60890107	P07877US00	1005	\$200.00	\$29,3
02/16 928	78822899	D597-6 78/822,899	7001	\$650.00	\$28,7
02/16 1	11030734	P06398US01-PHI 1598C	1806	\$180.00	\$28,5
02/16 1	10785146	P06268US02 - PHI 1433	1202	\$650.00	\$27,8
02/16 2	10785146	P06268US02 - PHI 1433	1201	\$600.00	\$27,2
02/16 3	10785146	P06268US02 - PHI 1433	1201	\$200.00	\$27,0
02/16 1995	78973899	K062-1 78/973,899	7002	\$100.00	\$26,9
02/16 4	10784355	P06603US01	1201	\$200.00	\$26,7
02/20 642	10367417	P04702US01	1251	\$120.00	\$26,6

2007.

P020-1063

add
claim

\$1450

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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SERIAL NO : 10/785,146
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Examiner :
Conf. No. : 8164
Docket No. : P06268US02 - PHI 1433C

SECOND PRELIMINARY AMENDMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

It is respectfully requested that this Second Preliminary Amendment be entered and made of record in response to the recent Board of Appeal decisions in U.S. Patent applications 10/000,311; 09/771,938; and 09/772,520 and the applicability of the reasoning of those Board decisions to the claims and arguments in the present case. The following amendments and remarks place the application in form for allowance. No new matter is presented, as such the Amendment is proper under 37 C.F.R. § 1.115. Applicant respectfully requests reconsideration.

=====

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

☐ deposited with the United States Postal Service with sufficient postage as First Class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Mail Stop Amendment, Alexandria, VA 22313-1450.

FACSIMILE

☒ transmitted by facsimile to the Patent and Trademark Office, Art Unit 1638 at Fax No. (571) 273-8300.

Date: 9-15-2005


LILA A. T. AKRAD

Exhibit A

Introductory Comments

Claims 1-12 are pending in the present application.

Amendments to the Specification begin on page 3 of this paper.

Amendments to the Claims are reflected in the listing of claims which begins on page 4 of this paper.

Remarks/Arguments begin on page 9 of this paper.

Amendments to the Specification

Please replace the paragraph at page 64, beginning at line 2, under the heading DEPOSITS with the following:

Applicant has made a deposit of at least 2500 seeds of Inbred Maize Line PH3RC with the American Type Culture Collection (ATCC), Manassas, VA 20110 USA, ATCC Deposit No. PTA-4672. The seeds deposited with the ATCC on September 18, 2002 were taken from the deposit maintained by Pioneer Hi-Bred International, Inc. [[7100]]7250 NW 62nd Avenue, Johnston, Iowa [[50131-1000]], ~~50131-0552 Des Moines, Iowa 50309-2340~~ since prior to the filing date of this application. Access to this deposit will be available during the pendency of the application to the Commissioner of Patents and Trademarks and persons determined by the Commissioner to be entitled thereto upon request. Upon allowance of any claims in the application, the Applicant will make the deposit available to the public pursuant to 37 C.F.R. § 1.808. This deposit of the Inbred Maize Line PH3RC will be maintained in the ATCC depository, which is a public depository, for a period of 30 years, or 5 years after the most recent request, or for the enforceable life of the patent, whichever is longer, and will be replaced if it becomes nonviable during that period. Additionally, Applicant has satisfied all the requirements of 37 C.F.R. §§ 1.801 - 1.809, including providing an indication of the viability of the sample upon deposit. Applicant has no authority to waive any restrictions imposed by law on the transfer of biological material or its transportation in commerce. Applicant does not waive any infringement of his rights granted under this patent or under the Plant Variety Protection Act (7 USC 2321 et seq). U.S. Plant Variety Protection of Inbred Maize Line PH3RC has been applied for under Application No. 200200257. Unauthorized seed multiplication prohibited. U.S. Protected Variety.

Amendments to the Claims

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

Independent Claim 1 (Original): A seed comprising at least one set of the chromosomes of maize inbred line PH3RC, representative seed of said line having been deposited under ATCC Accession No. PTA-4672.

Dep. Claim 2 (Previously presented): A maize plant produced by growing the seed of claim 1.

Dep Claim 3 (Original): A maize plant part of the maize plant of claim 2.

Ind. Claim 4 (Original): An F1 hybrid maize seed produced by crossing a plant of maize inbred line designated PH3RC, representative seed of said line having been deposited under ATCC Accession No. PTA-4672, with a different maize plant and harvesting the resultant F1 hybrid maize seed, wherein said F1 hybrid maize seed comprises two sets of chromosomes and one set of the chromosomes is the same as maize inbred line PH3RC.

dep Claim 5 (Original): A maize plant produced by growing the F1 hybrid maize seed of claim 4.

dep Claim 6 (Original): A maize plant part of the maize plant of claim 5.

Ind. Claim 7 (Currently amended): An F1 hybrid maize seed comprising an inbred [[corn]]maize plant cell of inbred maize line PH3RC, representative seed of said line having been deposited under ATCC Accession No. PTA-4672.

dep Claim 8 (Original): A maize plant produced by growing the F1 hybrid maize seed of claim 7.

dep. Claim 9 (Currently amended): The F1 hybrid maize seed of claim 7 wherein the inbred [[corn]]maize plant cell comprises two sets of chromosomes of maize inbred line PH3RC.

dep. Claim 10 (Original): A maize plant produced by growing the F1 hybrid maize seed of claim 9.

Ind. Claim 11 (Previously presented): A process of introducing a desired trait into maize inbred line PH3RC comprising:

- (a) crossing PH3RC plants grown from PH3RC seed, representative seed of which has been deposited under ATCC Accession No: PTA-4672, with plants of another maize line that comprise a desired trait to produce F1 progeny plants, wherein the desired trait is selected from the group consisting of waxy starch, male sterility, herbicide resistance, insect resistance, bacterial disease resistance, fungal disease resistance, and viral disease resistance;
- (b) selecting F1 progeny plants that have the desired trait to produce selected F1 progeny plants;
- (c) crossing the selected progeny plants with the PH3RC plants to produce backcross progeny plants;
- (d) selecting for backcross progeny plants that have the desired trait and the alleles of inbred line PH3RC at the SSR loci listed in Table 4 to produce selected backcross progeny plants; and
- (e) repeating steps (c) and (d) to produce backcross progeny plants that comprise the desired trait and comprise at least 95% of the alleles of inbred line PH3RC at the SSR loci listed in Table 4.

dep. Claim 12 (Previously presented): A plant produced by the process of claim 11, wherein the plant comprises at least 95% of the alleles of inbred line PH3RC at the SSR loci listed in Table 4.

Ind. Claim 13 (New): A maize plant having all the physiological and morphological characteristics of inbred line PH3RC, wherein a sample of the seed of inbred line PH3RC was deposited under ATCC Accession Number PTA-4672.

dep Claim 14 (New): A process of producing maize seed, comprising crossing a first parent maize plant with a second parent maize plant, wherein one or both of the first or the second parent maize plants is the plant of claim 13, wherein seed is allowed to form.

dep Claim 15 (New): The maize seed produced by the process of claim 14.

dep Claim 16 (New): The maize seed of claim 15, wherein the maize seed is hybrid seed.

dep Claim 17 (New): A hybrid maize plant, or its parts, produced by growing said hybrid seed of claim 16.

dep Claim 18 (New): A maize seed produced by growing said maize plant of claim 17 and harvesting the resultant maize seed.

dep Claim 19 (New): The maize plant of claim 13, further comprising an SSR profile in accordance with the profile shown in Table 4.

dep Claim 20 (New): A cell of the maize plant of claim 13.

dep Claim 21 (New): The cell of claim 20, wherein said cell is further defined as having an SSR profile in accordance with the profile shown in Table 4.

dep Claim 22 (New): A seed comprising the cell of claim 20.

dep Claim 23 (New): The maize plant of claim 13, further defined as having a genome comprising a single locus conversion.

dep Claim 24 (New): The maize plant of claim 23, wherein the single locus was stably inserted into a maize genome by transformation.

dep. Claim 25 (New): The maize plant of claim 23, wherein the locus is selected from the group consisting of a dominant allele and a recessive allele.

dep. Claim 26 (New): The maize plant of claim 23, wherein the locus confers a trait selected from the group consisting of herbicide tolerance; insect resistance; resistance to bacterial, fungal, nematode or viral disease; yield enhancement; waxy starch; improved nutritional quality; male sterility and restoration of male fertility.

dep. Claim 27 (New): The maize plant of claim 13, wherein said plant is further defined as comprising a gene conferring male sterility.

dep. Claim 28 (New): The maize plant of claim 13, wherein said plant is further defined as comprising a transgene conferring a trait selected from the group consisting of male sterility, herbicide resistance, insect resistance and disease resistance.

dep. Claim 29 (New): A method of producing a maize plant derived from the inbred line PH3RC, the method comprising the steps of:

- (a) growing a progeny plant produced by crossing the plant of claim 13 with a second maize plant;
- (b) crossing the progeny plant with itself or a different plant to produce a seed of a progeny plant of a subsequent generation;
- (c) growing a progeny plant of a subsequent generation from said seed and crossing the progeny plant of a subsequent generation with itself or a different plant; and
- (d) repeating steps (b) and (c) for an additional 0-5 generations to produce a maize plant derived from the inbred line PH3RC.

dep. Claim 30 (New): The method of claim 29 wherein the maize plant derived from the inbred line PH3RC is an inbred maize plant.

dep Claim 31 (New): The method of claim 30, further comprising the step of crossing the inbred maize plant derived from the inbred line PH3RC with a second, distinct inbred maize plant to produce an F1 hybrid maize plant.

dep Claim 32 (New): A method for developing a maize plant in a maize plant breeding program using plant breeding techniques comprising employing a maize plant, or its parts, as a source of plant breeding material comprising using the maize plant of claim 13, or parts thereof, as a source of said breeding material.

dep Claim 33 (New): The method for developing a maize plant in a maize plant breeding program of claim 32 wherein plant breeding techniques are selected from the group consisting of recurrent selection, backcrossing, pedigree breeding, restriction fragment length polymorphism enhanced selection, genetic marker enhanced selection, and transformation.

dep Claim 34 (New): The method of claim 33 wherein the plant breeding technique comprises the steps of:

- (a) obtaining the molecular marker profile of maize inbred line PH3RC;
- (b) obtaining an F1 hybrid seed for which maize inbred line PH3RC is a parent;
- (c) inducing doubled haploidy of the F1 hybrid seed to create progeny without the occurrence of meiotic segregation; and
- (d) selecting progeny that retain the molecular marker profile of PH3RC.

REMARKS

This Second Preliminary Amendment is being submitted in response to the recent Board of Appeal decisions in U.S. Patent applications 10/000,311; 09/771,938; and 09/772,520 and the applicability of the reasoning of those Board decisions to the claims and arguments in the present case. Applicant respectfully submits that this Second Preliminary Amendment will not unduly interfere with the preparation of the first Office Action.

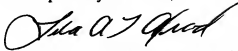
The present application relates to inbred maize line PH3RC. Claims 1-12 are pending in the present application. Claim 2 was amended and new claims 11 and 12 were added in the Preliminary Amendment filed June 16, 2005. Claims 7 and 9 are currently amended. Applicant acknowledges the addition of claims 13 through 34. The new claims do not add new matter as there is support for the claims in the originally filed specification. Support for the specific items can be found within the specification for herbicide tolerance on pages 38-40; insect resistance and resistance to bacterial, fungal, nematode or viral disease on pages 35-38; yield enhancement on pages 30-31; waxy starch and improved nutritional quality on pages 30-31; male sterility on pages 2-3 and 41; restoration of male fertility on pages 2-3; and 0-5 generations on pages 3-6. In addition, Applicant has amended the specification to clarify the deposit language. No new matter has been added. Entry of this Second Preliminary Amendment and approval of the changes is respectfully requested.

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested. If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

Please charge Deposit Account No. 26-0084 the amount of \$1,100.00⁴⁰⁰ for 14⁷⁰⁰ new claims over 20 (\$50 each) and 2 new independent claims over 3 (\$200 each). No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Lila A. T. Akrad".

LILA A. T. AKRAD, Reg. No. 52,550
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Attorneys of Record

- LATA/bja -